

Serial No. 10/790,968
Attorney Docket No. RS@W92004009US1
Response to Office Action mailed 2/23/2006

II. REMARKS.

A. Claim Objections. The examiner objected to claims 2, 3, 4, 5, and 6. Applicant has amended claims 2, 3, 4, 5 and 6 accordingly.

B. Claim Rejections 35 USC 102.

The Examiner rejected claims 1-12 and 15-34 under 35 USC 102(3) as being anticipated by US 20040142703 (Erb). Anticipation under 35 USC 102(b) "is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984). *See also* MPEP §2131. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1989). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). There must be no difference between the claimed invention and the referenced disclosure, as viewed by a person of ordinary skill in the art in the field of the invention. *Scripps Clinic & Research Found. v. Beentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

Although Erb and applicant's invention both use similar factors, such as position of a mobile device, to determine how an incoming call should be handled, each is fundamentally distinct from the other. The fundamental distinction is manifest by Erb's routing of a call to one or more telephones and/or wireless devices, while applicant's invention deals with how a single phone responds to a call received by that very phone.

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Specifically, Erb decides how to handle the incoming call before the call is actually delivered to and received by the telephone, and all Erb decision making occurs at the switching system. Erb's specification states that all "receiving" and "handling" of received calls occurs on the telephone switching system, "system 20," which decides how to handle the call before "directing" or "delivering" the phone call to the WCD (wireless communication device). See Erb [0017]: "the delivery of incoming calls directed to wireless communication devices can be controlled so that..." See Erb [0026]: "[t]he present invention relates to a system and method of controlling the delivery of an incoming call directed to a wireless communication device" and the term "incoming call" refers to "the delivery of a telephone call, in instant message or other form of communication directed to a wireless communication device." Also see Erb [0039]: "[t]he telephone system may be used in any environment where it is desired to control the delivery of incoming calls directed to wireless communication devices...." In other words, Erb's incoming call is received at the switching system, a determination is made by the switching system on where to direct the call, and then the call is delivered to a wireless communication device or an alternate device. No decisions are made by the telephone.

In stark contrast, applicant's telephone receives the call first, and then decides how to handle the call. All of applicant's decision making occurs at the telephone. Specifically, applicant's invention first receives an "incoming call" at the telephone, and then makes a determination at the phone on how the phone should respond (i.e. ring, vibrate, etc.). In other words, the "receiving" and "handling" of calls occurs on the actual telephone. See application, [0026]-[0027]: telephone 100 is described with cellular transceiver 102 and memory 114 which contains, among other things, Behavior Control Program BCP(300). Applicant's "incoming call"

Serial No. 10/790,968
Attorney Docket No. RS@W92004009US1
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means "a telephone call received by a telephone" [0019] and "telephone behavior" means "the action that a telephone takes in response to the reception of an incoming call" [0022].

In order to clarify this distinction, applicant has amended independent claims 1, 15, and 26 to clarify that the incoming call is received by the telephone and that "the telephone behavior is an action that the telephone takes in response to the reception of an incoming telephone call."

C. Claim Rejections 35 USC 103

The Examiner rejected claims 13 and 14 under 25 USC 103(e) as being unpatentable over Erb.

A patent claim is obvious when the differences between the claimed invention and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103; see also *Graham v. John Deere Co.*, 383 U.S. 1, 14, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). While obviousness is ultimately a legal determination, it is based on several underlying issues of fact, namely: (1) the scope and content of the prior art; (2) the level of skill of a person of ordinary skill in the art; (3) the differences between the claimed invention and the teachings of the prior art; and (4) the extent of any objective indicia of non-obviousness. See *Graham*, 383 U.S. at 17-18.

For the reasons stated above, claim 1 distinguishes over the prior art and therefore claim 6, and claims 13 and 14 distinguish over the prior art. Moreover, the examiner has not shown how it would be obvious to a person skilled in the art to perform the actions of claims 13 and 14 in regard to "an action that the telephone takes in response to the reception of an incoming telephone call."

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